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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,474	07/07/2003	Kimberly L. Person Hei	163.1404USC2	7611
Attn: Mark T. S	7590 04/20/200 Skoog .	EXAMINER		
MERCHANT & GOULD P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			MCAVOY, ELLEN M	
			ART UNIT	PAPER NUMBER
• ,			1764	
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SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/20/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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	Application No.	Applicant(s)				
	10/614,474	HEI ET AL.				
Office Action Summary	Examiner	Art Unit				
	Ellen M. McAvoy	1764				
The MAILING DATE of this communication app Period for Reply	pears on the cover sheet with the c	orrespondence address				
A SHORTENED STATUTORY PERIOD FOR REPL WHICHEVER IS LONGER, FROM THE MAILING D - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period - Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailin earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tin will apply and will expire SIX (6) MONTHS from a cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) filed on 29 J	anuary 2007.					
2a) ☐ This action is FINAL . 2b) ☒ This	This action is FINAL . 2b)⊠ This action is non-final.					
3) Since this application is in condition for allowa	3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under I	Ex parte Quayle, 1935 C.D. 11, 45	53 O.G. 213.				
Disposition of Claims						
4)⊠ Claim(s) <u>127-159</u> is/are pending in the applica	ition.					
4a) Of the above claim(s) is/are withdra	4a) Of the above claim(s) is/are withdrawn from consideration.					
5) Claim(s) is/are allowed.						
6)⊠ Claim(s) <u>127-159</u> is/are rejected.	6)⊠ Claim(s) <u>127-159</u> is/are rejected.					
7) Claim(s) is/are objected to.						
8) Claim(s) are subject to restriction and/o	or election requirement.					
Application Papers						
9) The specification is objected to by the Examine	er.					
10)⊠ The drawing(s) filed on <u>07 July 2003</u> is/are: a)⊠ accepted or b)□ objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.						
Priority under 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a) ☐ All b) ☐ Some * c) ☐ None of:						
1. Certified copies of the priority documents have been received.						
2. Certified copies of the priority documents have been received in Application No						
3. Copies of the certified copies of the priority documents have been received in this National Stage						
application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
Attachment(s)						
 Notice of References Cited (PTO-892) Notice of Draftsperson's Patent Drawing Review (PTO-948) 	4) Interview Summary Paper No(s)/Mail D					
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 14 pages. 	5) Notice of Informal F					

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- (1) Claim 136 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-31 of U.S. Patent No. 6,288,012. Although the conflicting claims are not identical, they are not patentably distinct from each other because the processes may be the same when the lubricant comprises a mixture of two or more types of substantially non-aqueous lubricants (dependent claim 31) selected from a polymer containing silicone, a polydimethylsiloxane compound and a polyalkylene glycol.
- (2) Claims 136, 147-149 and 158-159 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,495,494. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods may be the same when the mixture comprises 0.5 to 8 wt.%

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silicone material, 50-90 wt.% of a water-miscible lubricant such as a hydroxy-containing compound, a polyalkylene glycol or glycerol, and 2-49.5 wt.% water (dependent claim 8).

- (3) Claims 127-149, 156, 158 and 159 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 62-100 of U.S. Patent No. 6,673,753. Although the conflicting claims are not identical, they are not patentably distinct from each other because, aside from the exact wording, the compositions of claims 127-135 and 137-146 and the methods of claims 136 and 147-149, 156, 158 and 159 are substantially identical to the compositions and methods in the patent.
- (4) Claims 127-159 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6,207,622. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods and compositions may be the same when the lubricant composition comprises about 2 to about 10 wt.% of an oleophilic lubricating material selected from a silicone fluid, silicone emulsion, fluorochemical fluid and a hydrocarbon fluid; and about 65 to about 85 wt. % of a hydrophilic lubricating material selected from a hydroxy-containing compound, polyalkylene glycol, copolymer of ethylene and propylene oxides, sorbitan ester or derivative thereof; and about 8 to about 33 wt.% of water or other diluent.
- (5) Claims 136, 147-149 and 156-159 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 44- 48, 50-54 and 62-73 of copending Application No. 10/715,575. Although the conflicting claims are not

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identical, they are not patentably distinct from each other because the methods may be the same when the water-miscible silicone material of the co-pending application is a polysiloxane.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(6) Claims 136, 147-149 and 156-159 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 44-48, 50-54 and 62-73 of copending Application No. 10/715,692. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods may be the same when the water-miscible silicone material of the co-pending application is a polysiloxane.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ellen M McAvoy

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EMcAvoy April 14, 2007